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10/669,882	09/23/2003	Safaa H. Hashim	021756-060120US	5268
51206 7590 02/19/2009 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/669,882

**Applicant(s)**

HASHIM, SAFAA H.

**Examiner**

Natalie A. Pass

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-12, 15-28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-12, 15-28, 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 January 2009 has been entered.
2. This communication is in response to the Request for Continued Examination and amendment filed on 23 January 2009. Claims 1, 13-14, 29-30 have been cancelled. Claims 2, 18 have been amended. Grounds of rejection for claims 2-12, 15-28, 31-33 are set forth in detail below.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-12, 15-17 are rejected under 35 U.S.C. §101.

A) As per claims 2-12, 15-17, these appear to be directed toward a method or process of facilitating communication among at least one participant in an insurance-underwriting process. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as

a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., "data accessibility") is not a transformation because data is not statutory subject matter. Thus, claims 2-12, 15-17 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-12, 15-28, 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Surbey et al. (WO 0225470 A1) for substantially the same reasons given in the previous Office Action (paper number 20080903). Further reasons appear hereinbelow.

(A) As per newly amended claim 2, Surbey teaches a method for facilitating communication among at least one participant in an insurance-underwriting process (Surbey; page 12, paragraphs 1-2), the method comprising:

providing a web-based system for storing and organizing data related to the insurance-underwriting process (Surbey; Figure 7, Abstract, page 19, paragraph 2), the web-based system adapted to allow collaboration among the at least one participant via the Internet (Surbey; page 8, paragraph 1 to page 9, paragraph 1, page 12, paragraphs 1-2), the web-based system comprising a multi-level modular architecture, the multi-level modular architecture comprising a plurality of applications, each application of the plurality of applications comprising a plurality of modules, each module of the plurality of modules comprising a plurality of tools, each tool of the plurality of tools comprising a plurality of views (Surbey; Figure 2, Figure 9, page 14, paragraph 3, page 15, paragraph 2, page 21, paragraph 1 to page 22, paragraph 3); and

sharing, via the web-based system, the data among the at least one participant (Surbey; Figure 9, Item 9440, page 6, paragraph 3, page 8, paragraph 2); and

wherein the at least one participant comprises at least one user, the at least one user being associated with at least one role, the at least one role being operative to determine the plurality of modules available to the at least one user, and the data available to the at least one user (Surbey; Figure 9, Item 9314, page 8, paragraph 1 to page 9, paragraph 1, paragraph bridging pages 21-22), and

wherein the web-based system is adapted to restrict the data accessible to the at least one user based on a plurality of attributes of the at least one user, the plurality of attributes including an identity of the at least one user and a context in which the at least one user seeks access to the data (Surbey; Figure 6, Figure 9, page 7, paragraph 4 to page 9, paragraph 1, page 12, paragraphs 1-2, paragraph bridging pages 21-22); Examiner interprets a “virtual community” (reads on “context”) set up by a user in which “the software can enable the user to set ‘access rights’ with respect to each collaborator. Those access rights can identify, specify, and/or determine whether the collaborator can ‘read only’, ‘edit’, and/or ‘delete’ documents” (Surbey; page 8, paragraphs 2-4) to teach a form of restricting data accessibility “based on a plurality of attributes of the at least one user, the plurality of attributes including an identity of the at least one user and a context in which the at least one user seeks access to the data.”

(B) As per claims 3-7, Surbey teaches a method as analyzed and discussed in claim 2 above,

wherein the at least one participant is selected from the group consisting of: insurance carriers, insurance agencies, insurance agents, and service providers (Surbey; page 12, paragraph 1);

wherein the at least one user is selected from the group consisting of: agents and “client advisor[s]” (reads on “case managers” (Surbey; page 12, paragraph 1, page 13, paragraph 5);

wherein the plurality of applications are adapted to employ a desktop visual metaphor for accessing the plurality of modules (Surbey; Figure 5, Figure 9, page 4, paragraph 1, page 7, paragraph 4 to page 8, paragraph 3, paragraph bridging pages 11-12, page 12, paragraph 1, page 21, paragraph 1 to page 22, paragraph 2);

wherein the plurality of modules are adapted to allow the plurality of applications to be scalable (Surbey; Figure 9, page 3, paragraph 5, page 7, paragraph 1, page 21, paragraph 1 to page 22, paragraph 2); and

wherein the plurality of modules are purchased incrementally (Surbey; Figure 9, page 21, paragraph 1 to page 22, paragraph 2).

(C) As per claims 8-10, Surbey teaches a method as analyzed and discussed in claim 2 above,

wherein the plurality of modules comprises: a user profile module; a general administration module; and a business module (Surbey; Figure 9, page 21, paragraph 1 to page 22, paragraph 2);

wherein the plurality of tools comprises at least one generic tool and at least one entity-specific tool (Surbey; page 8, paragraph 3, page 16, paragraph 2); and

wherein the at least one generic tool is adapted to exist in more than one module with similar functionality (Surbey; page 8, paragraph 3, page 16, paragraph 2).

(D) As per claims 11-12, 15, Surbey teaches a method as analyzed and discussed in claim 2 above,

wherein the plurality of views comprises: a summary view; a list view; and a detail view (Surbey; Figure 5, page 7, paragraph 4 to page 8 paragraph 1);

wherein the multi-layer, modular architecture is adapted to allow development of new applications, modules, tools, or views (Surbey; page 6, paragraph 6); and

wherein the step of sharing the data further comprises encrypting the data using a secure encryption technology (Surbey; Figure 9, Item 9520, page 22, paragraph 3).

(E) As per claims 16-17, Surbey teaches a method as analyzed and discussed in claim 2 above,

wherein the web-based system is deployed on a portal hosted by a third party (Surbey; page 6, paragraph 6 to page 7, paragraph 3, paragraph bridging pages 9-10, page 15, paragraph 1, page 21, paragraph 4); and

wherein the web-based system is deployed on a framework for a plurality of applications (Surbey; Figure 8, Figure 9, page 21, paragraph 1 to page 22, paragraph 3).

(F) System claims 18-28, 31-33 repeat the subject matter of claims 2-12, 15-17 as a set of elements rather than a series of steps. As the underlying processes of claims 2-12, 15-17



have been shown to be fully disclosed by the teachings of Surbey in the above rejections of claims 2-12, 15-17, it is readily apparent that the Surbey reference includes the system to perform the recited functions. As such, these limitations are rejected for the same reasons provided above in the rejection of method claims 2-12, 15-17, and incorporated herein.

### ***Response to Arguments***

7. Applicant's arguments filed 23 January 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 23 January 2009.

(A) As per Applicant's argument on pages 8-9 of the response filed 23 January 2009 that the applied Surbey reference fails to disclose restricting the data accessible to the at least one user based on a context in which the user seeks access to the data, Examiner respectfully disagrees. Examiner notes that in paragraph 2 on page 8 of the response filed 23 January 2009 Applicant admits that the applied reference teaches restricting access to documents based on a user's role, however Applicant argues that the applied reference fails to teach restricting access based on "context." Examiner submits that Applicant's own Specification discloses that "[a] context can be characterized by one or more environmental factors that, in combination, sets the context of operation. For example, role, browser type, organization type (e.g., carrier, agency, or service provider), and others all combine to define a context that in turn defines how the application behaves in terms of the modules/tools/views available and the data accessible to a

user (emphasis added) (see Spec. paragraph [0056]). As such, Applicant appears to include a user's "role" within the definition of the term "context."

Further, Examiner notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, Surbey's teachings of a "virtual community" or environment set up by a user in which "the software can enable the user to set 'access rights' with respect to each collaborator. Those access rights can identify, specify, and/or determine whether the collaborator can 'read only', 'edit', and/or 'delete' documents" (Surbey; page 8, paragraphs 2-4) is a form of restricting data accessibility "based on a plurality of attributes of the at least one user, the plurality of attributes including an identity of the at least one user and a context in which the at least one user seeks access to the data," based on the broadest reasonable interpretation of this limitation. For these reasons, the rejection of claim 2 under 35 U.S.C. § 102(b) is proper and is thus maintained.

As per Applicant's argument on page 9 of the response filed 23 January 2009 that the applied Surbey reference fails to disclose limitations recited in claims 5 and 21, Examiner respectfully disagrees. Examiner submits that computer desktop images are well-known in the art to be visual metaphors, that is, visual representations of something else, such as files or folders or software applications or software modules, etc., that are opened or initiated or viewed or accessed by inputting commands using input devices; and Examiner further submits that the applied Surbey reference teaches "software that incorporates an electronic folder structure ... [...]"

... One way of visualizing this [metaphor] is an electronic filing cabinet that can provide the user with instant access to any file they have created or are entitled to access. These files can be accessed anywhere/anytime through an Internet connection" (Surbey; page 7, paragraph 4) and "[b]y clicking on the folder ("explorer") bar [i.e. a desktop icon], the user can select the appropriate folder and folder level ... [...] ... to select collaborators" (Surbey; page 8, paragraph 3), which Examiner interprets to be a form of adapted to employ a desktop visual metaphor for accessing the modules. As per Applicant's further arguments with regard to disclosures in the Specification, in the paragraph bridging pages 9-10, Examiner once again notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As per Applicant's argument in the paragraph bridging pages 10-11 of the response filed 23 January 2009 that the applied Surbey reference fails to disclose limitations recited in claims 16 and 32, Examiner respectfully disagrees. Examiner submits that Surbey teaches "[e]mbodiments of the present invention, however, can apply a new approach for accessing technology called the Application Service Provider (ASP) model and/or the Central Host model. One idea behind this technology is that instead of hundreds of participants in an industry each building their own proprietary software at great risk and expense the central hoster will develop the software once and make it available to anyone in the industry ... [...] ... This approach can have huge advantages for an industry like risk management and insurance. ... [...] ... The evolution of the Internet has made central hosting possible by providing a ubiquitous "pipeline" through which users anywhere in the world can access and use the software. ... [...] ... thereby

enabling brokers and insurers for the first time to be highly differentiated based upon their client service delivery” (Surbey; page 6, paragraph 6 to page 7, paragraph 2). Examiner interprets these teachings to be a form of portal hosted by a third party.

Furthermore, as per Applicant’s statements beginning with “[t]he Office Action asserts,” Examiner notes that Applicant appears to rely upon only a small subset of Examiner’s applied art. Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference, and not only the cited passages, as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to Applicant’s disclosure. The cited but not applied references, Nagel et al, U.S. Patent Number 7181017, DeWolf et al., U.S. Patent Application Publication Number 2002/0032626, Henley, U.S. Patent Application Publication Number 2002/0065758, Sabovich, U.S. Patent Application Publication Number 2002/0138306, Kelnsley et al., U.S. Patent Application Publication Number 2003/0154403, Henley, U.S. Patent Application Publication Number 2003/0195838,

Butman et al., U.S. Patent Number 5867665 teach the environment of collaborating using web clients over the Internet.

9. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./  
Examiner, Art Unit 3686  
February 4, 2009

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686